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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,137	07/31/2001	Adam S. Zane	20973-11	2895

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EXAMINER

BEKERMANN, MICHAEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/919,137	Applicant(s) ZANE ET AL.	
	Examiner Michael Bekerman	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/27/2002</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 27, 34, 41, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claim 27, the term “and/or” is used to describe the contents of the information database. The limitation should be either “and” or “or”, but not both.

Regarding claim 34, it is unclear as to what the steps of requiring entail.

Regarding claims 41 and 42, both claims recite the limitation “the grade sheet”, and both claims descend from claim 36. Claim 36 introduces a second grade sheet. It is unclear as to which grade sheet claims 41 and 42 are referring.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-7, 9 and 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. All claims are analyzed to determine if they set forth a useful, concrete, and tangible result. The

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aforementioned claims set forth the obtaining of and conversion of a grade report to a cash amount, but the mere conversion of a grade report is not seen as accomplishing a useful result without the customer receiving the cash amount. If applicant intends for there to be a use for the converted grade report (such as the providing of discounts based on the conversion, as mentioned in the specification), that use should be claimed..

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 3, 4, and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frank (Frank, Joe, "Good grades earn cut rates", St. Petersburg Times, July 10, 1989, Pg 12).**

Regarding claims 1 and 8-10, Frank teaches the obtaining of a grade report sheet and the converting of grades to a number (20% for A's, with 10% being the next limit and an inherent 0% for anything beyond that). The converting of that percentage to a cash amount would be inherent for giving the discount. While Frank teaches parents as getting involved with the program, he doesn't specify what that involvement entails. It would have been obvious to one having ordinary skill in the art at the time the

invention was made for a parent to be involved with any agreement their child enters into. That way, parents can keep their children out of trouble. Frank also teaches linear mapping (highest level – 20%, middle level – 10%, lowest level – 0%) and nonlinear mapping (highest level – 15%, middle level – 10%, lowest level – 0%).

Regarding claims 3 and 4, the allocation table is considered by the examiner to be a receipt. Official notice is taken that it is old and well-known that receipts can be hand written into a pre-printed table. This is a technique that is often used in older businesses that don't use computerized cash registers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to record the transaction information onto a hand-written receipt for the purposes of maintaining sale history and to provide a copy to the customer.

6. Claims 2 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frank (Frank, Joe, "Good grades earn cut rates", St. Petersburg Times, July 10, 1989, Pg 12) in view of Teng (U.S. Pub No. 2002/0107731).

Regarding claims 2, 5, and 6, Frank doesn't specify the good grades discount as being offered by a manufacturer. Teng teaches a discount reward being offered through rebate by General Motors (Paragraph 0003). It would have been obvious to one having ordinary skill in the art at the time the invention was made for the manufacturer to offer the discount program as a rebate. This would improve the sales of GM automobiles on a larger scale, and not just at one site. By offering a rebate, it would have been obvious to one having ordinary skill in the art at the time the invention was made that GM would need a copy of the receipt of the purchase for verification.

The GM rebate process proposed is taken to include a step of converting the percentage to a cash amount in order to refund the customer's money.

Regarding claim 7, Frank doesn't teach the storing of student purchase information in a database. It would have been obvious to one having ordinary skill in the art at the time the invention was made to keep a record of every sale made using the discount so that program effectiveness could be measured.

Claims 11-21, 25-27, and 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frank (Frank, Joe, "Good grades earn cut rates", St. Petersburg Times, July 10, 1989, Pg 12) in view of Teng (U.S. Pub No. 2002/0107731), and further in view of Gonzales (Gonzales, Daniel, "Making the grade on clothes store unusual incentive package; discounts for good marks in school", Syracuse Herald Journal, December 20, 1996, Pg A1).

Regarding claims 11, and 37-39, Frank teaches the obtaining of a grade report sheet and the converting of grades to a number (20% for A's, with 10% being the next limit and an inherent 0% for anything beyond that). The converting of that percentage to a cash amount would be inherent for giving the discount. While Frank teaches parents as getting involved with the program, he doesn't specify what that involvement entails. It would have been obvious to one having ordinary skill in the art at the time the invention was made for a parent to be involved with any agreement their child enters into. That way, parents can keep their children out of trouble.

Frank doesn't specify what kind of retailer should implement this reward system. Teng shows an example of General Motors implementing a rewards system for

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automobiles (Paragraph 0003). It would have been obvious to one having ordinary skill in the art at the time the invention was made for any retailer to implement this system in order to show support for the community while raising sales.

Frank also doesn't specify a rebate program. Teng shows GM offering a rebate program to reward certain consumers (Paragraph 0003). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a rebate discount for consumers who have good grades in school. By GM giving out the rebate on a corporate level, this would allow GM to keep a closer eye on the entire reward program.

Neither Frank nor Teng specify the grade report being physically brought into the retail establishment. Gonzales teaches a student bringing the grade report to the retail establishment. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the student physically bring the grade report to the automobile dealership. This would allow the dealership to double-check the grade report to ensure that everything is in order.

Regarding claims 12-14, 25, 26, the allocation table is considered by the examiner to be a receipt. Official notice is taken that it is old and well-known that receipts can be hand written into a pre-printed table. This is a technique that is often used in older businesses that don't use computerized cash registers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to record the transaction information onto a hand-written receipt for the purposes of maintaining sale history. It would have also been obvious to one having ordinary skill in

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the art at the time the invention was made that the customer would receive a copy of the receipt for the customer's records. By offering a rebate, it would have been obvious to one having ordinary skill in the art at the time the invention was made that GM would need a copy of the receipt of the purchase for verification. The GM rebate process proposed is taken to include a step of converting the percentage to a cash amount in order to refund the customer's money.

Regarding claim 15, 27, Frank doesn't teach the storing of student purchase information in a database. It would have been obvious to one having ordinary skill in the art at the time the invention was made to keep a record of every sale made using the discount so that program effectiveness could be measured.

Regarding claim 16, the rebate is considered to be a cash refund of a discount off the purchase price of an item.

Regarding claims 17 and 18, Frank teaches linear mapping (highest level – 20%, middle level – 10%, lowest level – 0%) and nonlinear mapping (highest level – 15%, middle level – 10%, lowest level – 0%).

Regarding claim 19, Frank, Teng, and Gonzales don't specify a copy of the grade report being sent to a manufacturer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to send a copy of the grade report to the manufacturer along with the receipt in order to get the rebate. This way, the manufacturer could double-check the grade report to make sure everything is in order.

Regarding claims 20 and 21, Frank teaches both letter grades (all A's) and grade points (3.2 average).

Regarding claim 40, Frank, Teng, and Gonzales don't specify the keeping of a database of cash-equivalent amounts. Official notice is taken that it is old and well-known to keep a database of sale prices for items during sale periods. Department stores like Hechts and Belk will keep databases of sales and sale prices due to those sales changing constantly. It would have been obvious to one having ordinary skill in the art at the time the invention was made to keep a database of which items would be on sale at which prices for obtaining good grades. This would make it easier for employees to figure out sales prices.

Regarding claims 41 and 42, as best understood, Frank teaches the promotional offer as lasting for 3 months after the grading period ends. It would have been obvious to one having ordinary skill in the art at the time the invention was made to reward current behavior by setting a time limit for the promotional offer, that time limit being any length that would be beneficial to the manufacturer.

Claims 22-24, 28-36, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frank (Frank, Joe, "Good grades earn cut rates", St. Petersburg Times, July 10, 1989, Pg 12) in view of Gonzales (Gonzales, Daniel, "Making the grade on clothes store unusual incentive package; discounts for good marks in school", Syracuse Herald Journal, December 20, 1996, Pg A1).

Regarding claims 22, 30-34, and 43, Frank teaches the obtaining of a grade report sheet and the converting of grades to a number (20% for A's, with 10% being the

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next limit and an inherent 0% for anything beyond that). The converting of that percentage to a cash amount would be inherent for giving the discount. While Frank teaches parents as getting involved with the program, he doesn't specify what that involvement entails. It would have been obvious to one having ordinary skill in the art at the time the invention was made for a parent to be involved with any agreement their child enters into. That way, parents can keep their children out of trouble. Frank doesn't specify the grade report being physically brought into the retail establishment. Gonzales teaches a student bringing the grade report to the retail establishment. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the student physically bring the grade report to the retail establishment. This would allow the retailer to double-check the grade report to ensure that everything is in order.

Regarding claims 23 and 24, the allocation table is considered by the examiner to be a receipt. Official notice is taken that it is old and well-known that receipts can be hand written into a pre-printed table. This is a technique that is often used in older businesses that don't use computerized cash registers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to record the transaction information onto a hand-written receipt for the purposes of maintaining sale history. It would have also been obvious to one having ordinary skill in the art at the time the invention was made that the customer would receive a copy of the receipt for the customer's records.

Regarding claims 28 and 29, Frank teaches linear mapping (highest level – 20%, middle level – 10%, lowest level – 0%) and nonlinear mapping (highest level – 15%, middle level – 10%, lowest level – 0%).

Regarding claim 35, neither Frank nor Gonzales specifies the keeping of a database of cash-equivalent amounts. Official notice is taken that it is old and well-known to keep a database of sale prices for items during sale periods. Department stores like Hechts and Belk will keep databases of sales and sale prices due to those sales changing constantly. It would have been obvious to one having ordinary skill in the art at the time the invention was made to keep a database of which items would be on sale at which prices for obtaining good grades. This would make it easier for employees to figure out sales prices.

Regarding claim 36, neither Frank nor Gonzales specifies the program policy on multiple grade reports. It would have been obvious to one having ordinary skill in the art at the time the invention was made to give a discount for every grade report sheet brought in and meeting the reward program criteria. This would give credit to the student for getting good grades.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art in reference to student achievement reward programs and retail discounts:

Framer, Robin, "Industries make reform of teaching a priority", Richmond Times, October 21, 1991,
Pg A1

Yip, Pamela, "Young Driver deals/Insurers propose two discounts", Houston Chronicle, August 15,
1992, Pg 1.

Boggs, Alison, "A for Automobile Car presented at Lake City High as an academic reward",
Spokesman Review, May 31, 2000, Pg B1.

Eskenazi, Stuart, "Car insurance discount approved; Students with good - grades could soon
receive 10 percent break on automobile premiums", Austin American Statesman, November 20,
1996, Pg B4


Agins, Teri, "Oh Please, Teacher, Give Me an A So I Can Get That Hot Red Dress", Wall Street
Journal, September 21, 1992, Pg B1

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Michael Bekerman whose telephone number is (571)
272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone
number for the organization where this application or proceeding is assigned is 571-
273-8300.

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Business Center (EBC) at 866-217-9197 (toll-free).

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JEFFREY D. CARLSON
PRIMARY EXAMINER